The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte ROBERT W. ALLPORT,
STEPHEN KELLY, TIMOTHY J. NICHOLLS,
and FREDERICK W. RYAN JR

_____

Appeal No. 2003-0328
Application 09/223,116

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ON BRIEF

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Before JERRY SMITH, BARRETT, and BARRY, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-12, which constitute all the claims in the application.

The disclosed invention pertains to a method and apparatus for selecting and accounting for value-added services with a closed postage metering system.

Representative claim 1 is reproduced as follows:

1. A method for selecting and accounting for value-added services with a closed system metering device, the method comprising:

coupling a scanning device to a closed system postage meter;

scanning information, including recipient address, printed on a mailpiece;

determining if value-added services are desired;

performing accounting related to the desired value-added services;

combining the recipient address with other information relating to the postage payment for the mailpiece to obtain postal data relating to the mailpiece;

using the postal data to generate an indicium for the mailpiece, the indicium including cryptographic evidencing of postage payment;

adding graphical representation of the desired value-added services to the generated indicium to generate a value-added indicium; and

printing the value-added indicium on the mailpiece

The examiner relies on the following references:

Brookner et al. (Brookner)	6,009,417	Dec. 28, 1999 (filed Mar. 16, 1999)
Pauschinger	6,041,704	Mar. 28, 2000 (filed Dec. 09, 1997)
Kubatzki et al. (Kubatzki)	6,064,994	May 16, 2000 (filed May 02, 1997)

Claims 1-12 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Brookner in view of Pauschinger and Kubatzki.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in the claims on appeal. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore

Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 1.192(a)].

The examiner has indicated how he finds the claimed invention to be obvious over the combined teachings of the applied prior art [answer, pages 3-6]. With respect to independent claim 1, after considering the individual deficiencies of each of the applied references, appellants argue that there is no teaching or suggestion in any of the applied

references of the step of combining the recipient address with other information relating to the postage payment for the mailpiece to obtain postal data relating to the mailpiece, and using the postal data to generate an indicium for the mailpiece, the indicium including cryptographic evidencing of postage payment as set forth in claim 1. Appellants also argue that the operations described in Kubatzki do not constitute value-added services as claimed, and there is no accounting related to desired value-added services. Appellants argue that the applied references do not teach the step of adding graphical representation of the desired value-added services to the general indicium to generate a value-added indicium as claimed [brief, pages 9-16].

The examiner responds that incorporating postage data such as address data, date or meter data into a digital proof of postage is admitted prior art because appellants failed to challenge the examiner's taking of Official Notice of this fact. The examiner also asserts that the steps of claim 1 are not connected and do not require that the address information come from the scanning step. The examiner also responds that appellants are attempting to limit the meaning of "value-added services" by incorporating limitations from the specification

into the claim. In summary, the examiner does not find any of appellants' arguments to be persuasive of error in the rejection [answer, pages 6-9].

Appellants respond that they did not fail to challenge the examiner's taking of Official Notice that it was known to incorporate address data into the digital proof of postage in a closed system metering device. Appellants argue that they have consistently asserted that inclusion of the recipient's address in closed systems has not been possible in the prior art [reply brief, pages 1-3]. Appellants also argue that the scanning in claim 1 is clearly being performed by the scanner that is coupled to the closed system postage meter, and the determining step is clearly related to the scanning step and the scanned information and cannot be satisfied by a manual indication. Thus, appellants argue that the claimed indicium must include at least some part of the recipient's address [id., pages 3-5].

A decision on the patentability of claim 1 cannot be made until the scope of claim 1 is determined. Appellants and the examiner disagree on what is required by claim 1. In our view, the key steps of claim 1 are the "combining" step and the "using" step. The combining step recites "combining the recipient address with other information relating to the postage payment

for the mailpiece to obtain postal data relating to the mailpiece," whereas the using step recites "using the postal data to generate an indicium for the mailpiece, the indicium including cryptographic evidencing of postage payment" [underlining added]. The phrase "the recipient address" in the combining step refers back to the scanning step where the recipient address is introduced. Therefore, we agree with appellants that the recipient address of the combining step comes from the scanning step. The combining step also recites that the postal data is obtained by combining the recipient address with other information. Therefore, we also agree with appellants that the postal data includes at least some part of the recipient address since the recipient address is combined with the other information.

The using step of claim 1 recites that the postal data, obtained from the combining step, is used to generate an indicium for the mailpiece. As noted above, the postal data includes at least some part of the recipient address. Therefore, the indicium generated from the postal data also includes at least some part of the recipient address. Accordingly, we find that claim 1 requires that the indicium for the mailpiece includes at least some part of the recipient address.

There is no teaching within the applied prior art of incorporating a recipient address within a generated indicium for a mailpiece. The examiner took Official Notice that it was well known to incorporate "address data, date or meter data into a digital proof of postage." Although there is little doubt that it was well known to incorporate date and meter data into a digital proof of postage, there is no evidence that it was well known to incorporate recipient address data into a digital proof of postage in a closed system metering device. We agree with appellants that they have properly challenged the examiner's Official Notice with respect to the address data portion of the examiner's position. Appellants have consistently asserted that it was not well known to include the recipient address in a digital proof of postage in a closed metering system.

Since the examiner's taking of Official Notice has been properly challenged by appellants, and since the record before us does not otherwise support the examiner's finding with respect to the taking of Official Notice, we find that the examiner has failed to find every feature of the claimed invention. Therefore, we do not sustain the examiner's rejection of claims 1-7.

With respect to independent claim 8, it recites limitations similar to claim 1. Claim 8 recites that the generating means generates an indicium using the scanned information including the recipient address. Therefore, claim 8 requires that the recipient address information be obtained by the scanning means. Claim 8 also recites that the indicium is generated using the recipient address. Therefore, we find that claim 8, like claim 1, also requires that an indicium be generated which incorporates the recipient address information therein. As discussed above, this record does not support the finding that it was well known to incorporate recipient address information in a digital proof of postage for a closed system postage metering device. Therefore, we do not sustain the examiner's rejection of claims 8-12 for the same reasons discussed above with respect to claim 1.

In summary, we have not sustained the examiner's rejection with respect to any of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-12 is reversed.

REVERSED

JERRY SMITH Administrative Patent Judge	)
LEE. E. BARRETT Administrative Patent Judge	) BOARD OF PATENT)) APPEALS AND)) INTERFERENCES
LANCE LEONARD BARRY Administrative Patent Judge	)

JS/dym

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